

REMARKS

Reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

The pending claims are 91-97 and 99-119.

Rejections Under 35 USC § 103(a)

Claims 91 – 97, 99 – 101, 111, 112, 114 and 116 stand rejected under § 103 (a) over Miyamoto et al. (US 4,460,637) in view of Asaka et al. (US 5,437,913). This rejection is respectfully traversed.

The claimed invention as recited in claim 91 is to a paper substrate in combination with a two layer coating, with the coating on each side of the substrate. Furthermore, claim 91 recites the use of calcium carbonate as the pigment for the top layer and that 80% of the calcium carbonate particles are smaller than 1 μ . Still further, claim 91 recites that calcium carbonate is also the pigment that is used in the intermediate layer. Further, applicants claim a cumulative porosity volume for the total coating system.

None of the foregoing features recited in claim 91 are disclosed in the Miyamoto reference.

The Examiner seeks to remedy this deficiency in the primary teaching reference by combining its teachings with that of the secondary reference, namely Asaka et al.

Asaka et al. (US 5,437,913) is said by the Examiner, at page 5 of the Office Action, to disclose a printing sheet comprising an image receptive coating provided on both sides of the substrate (col. 6, lines 12-24).

It is respectfully submitted that the position taken by the Examiner with respect to the Asaka et al. reference is incorrect with respect to the use of a ***fibrous paper web***, since the Asaka reference only discloses the use of transfer films where the substrate is

transparent. The Asaka disclosure is completely silent with respect to any teaching with respect to a fibrous paper web. In addition, the remaining elements recited in claim 91 are not disclosed by Asaka et al.

Since the Examiner has not established a *prima facie* case of obviousness, the rejection has been overcome and its withdrawal is respectfully solicited.

Claims 102 – 104, 107, 109, 112 and 113 stand rejected under 35 USC § 103(a) over the combination of Miyamoto et al. and Asaka et al. in view of Desie et al. (US 5,418,078). This rejection is respectfully traversed.

The Examiner seeks to remedy the deficiencies in the combination of Miyamoto and Asaka et al., by adding thereto the teachings of a tertiary reference.

The basic deficiencies which inhere in the primary and secondary references with respect to independent claim 91, cannot be ameliorated by the teachings of a tertiary reference with respect to claims which are dependent upon independent claim 91.

Accordingly, it is respectfully submitted that dependent claims 102-104, 107, 109, 112 and 113 also clearly distinguish over the trilogy of references employed by the Examiner. Since the claims distinguish over the art of record, withdrawal of the rejection under § 103(a) is respectfully solicited.

Claims 105 and 106 have been rejected under 35 USC § 103(a) as being unpatentable over the combination of Miyamoto et al., Asaka et al. and Desie et al. in view of Le-Khac (US 4,408,010). This rejection is respectfully traversed.

The addition of yet another reference to the already lengthy chain of references, does not serve to bolster the deficient teachings of the three (3) prior references with respect to dependent claims 105 and 106. These claims, which depend directly from independent claim 91, also serve to distinguish over the art of record for the reasons which have previously been advanced. Since the claims are believed to distinguish over

the art of record, withdrawal of the rejection is in order and is respectfully solicited.

Claims 108 and 115 have been rejected under 35 USC § 103 as being unpatentable over Miyamoto et al., Asaka et al., Desie et al. and Le-Khac, view of Uytterhoven et al. (US 5,418,110). This rejection is respectfully traversed.

These dependent claims ultimately depend from independent claim 91, which fully distinguish over the five (5) references of record for the reasons set forth previously. The addition of yet another reference to the four (4) already applied, does not serve to overcome deficiencies in the combined teachings of the art applied by the Examiner. In view of the foregoing, it is respectfully submitted that the claims distinguish over the art of record, and, as such, the rejection has been overcome and should be withdrawn.

Claims 110 and 117-119 have been rejected under 35 USC § 103(a) as being unpatentable over Miyamoto et al., Asaka et al., in view of Liu et al. (EP 0 803 374). This rejection is respectfully traversed.

These dependent claims, which depend ultimately from claim 91, also serve to distinguish over the art of record for the reasons set forth previously, with respect to the rejection of independent claim 91. Accordingly, since the claims distinguish over the art of record, the withdrawal of the rejection is in order and is respectfully solicited.

Applicants respectfully submit that the combined prior art teachings neither disclose nor suggest the specific combination of a fibrous paper web which is coated on both sides with a two layer structure having a specific pigment composition, namely, comprising at least fifty (50) parts of calcium carbonate with a particle size distribution such that more than 80% of the particles are smaller than 1 μ .

The Examiner in his zeal to "nail down" each and every claimed element in independent claim 91, as well as the dependent claims, has employed a multiplicity of attenuated references to arrive at his sought-after goal. It is submitted that the Examiner

has lost sight of the requirement of § 103(a) that the claimed invention be analyzed "as a whole." As the Federal Circuit said in *In re Wright* (6 USPQ2d 1959 (1988)):

"[I]t is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves."

Since the rejections of record under 35 USC § 103(a) are deemed to have been overcome, their withdrawal is respectfully solicited and the issuance of a Notice of Allowance is respectfully requested.

Please charge any fees which may be due and which have not been submitted herewith to our Deposit Account No. 01-0035.

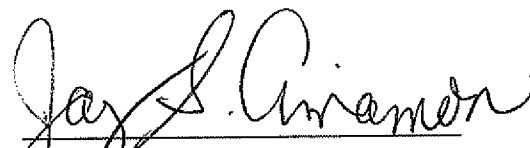
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Respectfully submitted,

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